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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,817	01/16/2004	George Garrity	MSU-08334	8033
23535	7590	08/27/2010	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			ZEMAN, MARY K	
ART UNIT	PAPER NUMBER		1631	
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08/27/2010	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/759,817	<b>Applicant(s)</b> GARRITY ET AL.
	<b>Examiner</b> Mary K. Zeman	<b>Art Unit</b> 1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 April 2010.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 and 17-29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13, 17-29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/GS-68)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/13/10 has been entered.

Claims 1-13 and 17-29 are pending in this application.

The amendments and arguments filed 4/13/10 have been entered, and carefully considered. These amendments overcome the rejection made under 35 USC 101. However, in a subsequent search, the following art has been identified and is applied below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7- 13, 17, 18, 20,-23, 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Theodorakis et al. (1997).

Theodorakis et al. (Theodorakis et al. Int.. J of Cooperative Information Systems (Sept-Dec-1997) Vol 6, no 3-4 pages 269-292) provides methods of resolving ambiguous naming systems within databases. Within networked systems, the method provides software which identifies objects with ambiguous identifications (section 3.1, page 272), and through various

path schemes determines a persistent unique identifier for the object (section 5, page 277). This unique identifier is accessible through normal networked processors and computers. The identifier is addressed by content and path identifiers, through object identifiers, such as DOI. Content associated with the object includes attributes such as descriptive text or context (section 6.3, page 284.) Once the persistent identifier is created, it is linked in an "active region" such as a hyperlink to other names, context information, data or pathways. As such, the invention as claimed is anticipated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-6, 14-16, 19, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theodorakis et al. as applied to claims 1, 7- 13, 17, 18, 20,-23, 25-29, in view of Remsen (US 2003/0167283, of record.).

Claims 2-8 specify that the data to be curated is biological data. The nature of the data does not change the method steps, or system attributes. The data itself is non-functional descriptive material.

Theodorakis et al. (Theodorakis et al. Int.. J of Cooperative Information Systems (Sept-Dec-1997) Vol 6, no 3-4 pages 269-292) provides methods of resolving ambiguous naming systems within databases. Within networked systems, the method provides software which identifies objects with ambiguous identifications (section 3.1, page 272), and through various

path schemes determines a persistent unique identifier for the object (section 5, page 277). This unique identifier is accessible through normal networked processors and computers. The identifier is addressed by content and path identifiers, through object identifiers, such as DOI. Content associated with the object includes attributes such as descriptive text or context (section 6.3, page 284.) Once the persistent identifier is created, it is linked in an "active region" such as a hyperlink to other names, context information, data or pathways. Theodorakis does not specify the use of biological data, but the disclosure of the methods is generic to any type of data.

Remsen et al (US 2003/0167283) provide a universal organism name resolution and classification system. This system is an object oriented database for resolving names and classification of organisms. Biocentric information (scientific name, trivial name, properties, identifying characteristics, as well as third party information) is used in the system. The system is used to provide taxonomic services. Organismal name information is provided, and a particular object is assigned to that name. Using the object, the name is matched or correlated with stored information to provide a taxonomic name and organizational assignment in a hierarchy. The system uses Taxon tables and a classification table. The Taxon table consists of taxon identifiers, a name table where each entry is associated with a taxon identifier and a classification table. A taxon is associated with semantic data and syntactic data. Data sources can be static or dynamic, and may be third party data sources.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have applied the information architecture structures and methods of Theodorakis to the biological names as set forth by Remsen. The data itself does not change the structures of the system, or the methods of creating persistent unique identifiers, it merely provides differing context information. It was well known in the art at the time of the invention that naming of biological data was complex. One of skill in the art would have been motivated to provide persistent, addressable information objects for biological named materials to overcome this complex naming problem. One of skill in the art would have had a reasonable expectation of success at implementing the architecture and object assignment to the information in Remsen as

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the same computer and database programming skills are required. Therefore, the invention would have been *prima facie* obvious to one of skill in the art absent evidence to the contrary.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjie Moran can be reached on (571) 272 0720. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Mary K Zeman/  
Primary Examiner, Art Unit 1631